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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,295	06/01/2006	Sudhir Paul	64229-2150	3691
20311 7590 10/14/2011 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
PENG, BO				
ART UNIT		PAPER NUMBER		
1648				
NOTIFICATION DATE		DELIVERY MODE		
10/14/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

Office Action Summary**Application No.**

10/581,295

Applicant(s)

PAUL, SUDHIR

Examiner

BO PENG

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Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 51-65 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 51-65 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-501)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

1. This Office action is in response to Applicant's reply filed on September 2, 2011.

Claims 51-65 are pending and are considered in this Office action.

Claim Rejections - 35 USC 112, first paragraph-Written description

2. The following is a quotation of the first paragraph of 35 USC 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **(Prior rejection-maintained)** The rejection of Claims 51-65 under 35 USC 112, first paragraph, for failing to comply with written description requirement, is **maintained** for the reason of record.

In response to Applicant's argument:

4. Applicant argues that the law establishes that a general allegation of unpredictability in the art is not a sufficient reason to support a rejection for lack of adequate written description. *Hyatt v. Dudas*, 492 F.3d 1365, 1370, 83 USPQ2d 1373, 1376 (Fed. Cir.2007). Applicant asserts that it is irrelevant what the definition of antibody is or that one of ordinary skilled in the art could not know what specific diseases the claimed antibody or fragment thereof treats. **Because the reaction antigen/antibody is specific and selective, once the sequences of the light and heavy chain variable domains are known, a person skilled in the art is be capable of extrapolating the correspondent antigenic sequences without undue experimentation and with reasonable expectation of success.** Most importantly, the presently claimed subject matter is not directed to a method of treatment of a specific disease, but rather is directed to specific antibodies which are well described and supported by the specification.

5. Applicant's argument is not persuasive for following reasons: Applicant appears to argue that the claimed invention is enabling. However, the rejection is made under 35 USC 112, first paragraph, because the claimed invention lacks written description. The

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claims describe the claimed antibody only by fragments of SEQ ID NO: 43, 44 or 46. The claims have failed to indicate which specific antigen the claimed antibody or fragments would interact. However, based on the definition of an antibody, an antibody is defined by its specificity of reacting to antigen, not by amino acid fragments. Without adequate description of the specificity, one of ordinary skill in the art cannot envision what is the claimed antibody or fragment thereof.

6. Moreover, the description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") In the present case, the claims lack adequate description of "a pharmaceutical composition" comprising fragments of SEQ ID NO: 43, 44 or 46. The specification has not shown that the claimed antibody or fragment can be used for treating any specific diseases or viral infections, providing clinical benefit. Given that a lack of indication of the specificity of the claimed antibody fragment, one of ordinary skill in the art cannot envision what specific diseases the claimed antibody fragment is capable of treating.

7. Accordingly, it is deemed that the specification fails to provide adequate written description for the claimed antibody fragments and pharmaceutical composition. Since Applicant's argument has failed to indicate the antigen of the claimed antibody fragment, it is not sufficient to overcome the rejection. The rejection is therefore maintained.

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Remarks

8. No claims are allowed. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bo Peng, Ph.D. whose telephone number is 571-272-5542. The examiner can normally be reached on Tu-F, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Zachariah Lucas can be reached on 571-272-0905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/BO PENG/
Primary Examiner, Art Unit 1648